

REMARKS/ARGUMENTS

This Amendment is responsive to the Office Action mailed on September 19, 2006.

In this Amendment, claims 1, 13, 18, 20, 32, 37, 39, and 56 are amended, no claims are canceled, and claims 58-61 are added so that claims 1-2, 4-14, 16-21, 23-28, 30-33, 35-40, 42-52, and 54-61 are pending and subject to examination on the merits. Support for new claims 58-61 can be found at page 14 of the present application.

35 USC 103 - Deo et al. and Carlisle et al.

At page 3 of the Office Action, claims 1-2, 4-14, 16-17, 19-21, 23-28, 30-33, 35-36, 38-40, 42-52, 54-55, and 57 are rejected as obvious over Deo et al. (U.S. Patent No. 6,970,891) in view of Carlisle et al. (U.S. Patent No. 5,649,118). This rejection is traversed.

Obviousness has not been established. Here, the primary reference, Deo et al., fails to teach or suggest at least the following limitation from independent claim 1: "wherein the one or more attributes associated with the directory, cell group, or cell are associated with a passcode or a key, wherein the client is adapted to use the passcode or key to access data in the directory, cell group, or cell." The other independent claims recite a similar limitation.

Referring to FIGS. 1 and 2 from Deo et al. below, and col. 3, line 63 to col. 4, line 13, Deo et al. uses a file system 118 on an IC module 100 embodied as a smartcard (col. 3, line 17) to enforce levels of security for access to volatile files 122.

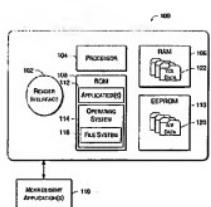


Fig. 1

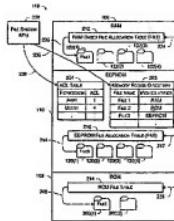


Fig. 2

In embodiments of the invention, passcodes or keys may be used by applications residing in a client that is external to a smartcard (e.g., in a POS or point of sale terminal) to allow those applications to access specific directories, cell groups, or cells on the smartcard. Passcodes and keys are not taught, suggested, or desired in Deo et al., since the file system 118 uses an "access control list (ACL)" (c. 3, l. 67 of Deo et al.).

There is also no motivation to modify Deo et al. to include passcodes or keys. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.01. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01. Here, if one were to modify Deo et al. to arrive at the inventions of the pending claims, one would render an essential part of Deo et al.'s system (i.e., the file system 118 and its associated access control list) obsolete. As explained at col. 3, line 44 to col. 4, line 7, the file system 118 is essential to the operation of Deo et al.'s smartcard and resides inside of the smartcard. If one were to modify Deo et al. to include a client terminal that uses passcodes or keys to access data on a secure token, there would be no need for Deo et al.'s file system 118 and its access control list, since access to directories, cell groups, and cells would already be restricted.

35 USC 103 - Deo et al., Carlisle et al. and Brittenham et al.

Claims 18, 37, and 56 are rejected as being obvious over Deo et al., Carlisle et al., and Brittenham et al. (U.S. Patent No. 6,880,084). This rejection is traversed.

Brittenham et al. is cited for its alleged teaching of the features recited in dependent claims 18, 37, and 56. Applicants submit that the combination of Deo et al. and Carlisle et al. is improper for the reasons provided above, and that the additional citation of Brittenham et al. fails to cure the deficiencies of the improper combination.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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